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Feb. 05 2003 08:21AM P1/7

PATENT

Docket 13DV-14203

2-6-03
A. Coonan

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:)
Ching Pang Lee et al)
)
) Art Unit: 3746
)
Application No.: 10/028,108)
Confirmation No: 3092) Examiner: Koczko, M.
)
Filed: 12/20/2001)
)
Title: Ventilated Thermal)
Barrier Coating)

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Provisional Election

FEB 05 2003

GROUP 3700

Box Non-Fee Amendment
Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the restriction requirement dated as mailed on 01/27/03, and having a period of response extending through and including 02/27/03, Applicants provisionally elect Group I, and claims 1 to 15 therein; and Species B, and claims 4-21 readable thereon, with traverse.

The examiner has indicated a seven-way restriction, but has failed to provide the corresponding seven independent and distinct bases therefor as required by the MPEP, rendering the restriction requirement unsubstantiated and unwarranted.

The examiner's characterizations of the claims fails to comply with the MPEP, and fails to meet the several different requirements therein which must be met by the examiner in establishing a basis to restrict.

More specifically, Applicants traverse the examiner's

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5 Feb 2003
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PATENT

Docket 13DV-14203

characterization of "subcombination and combination" of groups I-VII since all 21 claims are **combination** claims, with claims 2-21 being **species** of claim 1.

Note that claim 1 expressly recites a "gas turbine engine component," and all claims 2-21 are species thereof as found in a gas turbine engine, including the liner of claim 16, the vane of claim 17, the nozzle band of claim 18, the blade of claim 19, the shroud of claim 20, and the liner of claim 21.

Notwithstanding the examiner's indication of search classes for the seven groups, those search classes must nevertheless all be searched in a proper examination of the provisionally elected Group I claims.

The examiner's use of MPEP 806.05(c) is incomplete, erroneous, and fails to conform with other applicable provisions of the MPEP.

Note that figures 1-3 illustrate a common configuration for the recited engine component, which component can be any of the several species shown schematically; and MPEP 806.03 indicates that restriction should "never be required."

MPEP 806.04(b) governs species that may also be related inventions as in claims 1-21; and mandates **two tests** by the examiner, and that "If restriction is improper under either practice, it should not be required."

MPEP 806.04(d) governs the definition of a generic claim, and the examiner has already admitted that: "Currently, claims 1 and 2 are generic;" with it being also noted that claim 4 is additionally generic to independent claims 16-21.

MPEP 806.04(f) requires species to be mutually exclusive, yet independent claims 16-21 are not mutually exclusive of the generic claims, but species thereof.

MPEP 806.05(c) requires that "two-way distinctiveness must be demonstrated" by the examiner, and the examiner has not done so for any two groups, and for the multitude of permutations of the seven groupings.

The examiner contends that groups II to VII are combination claims, and that group I has subcombination

PATENT

Docket 13DV-14203

claims; yet this is clearly erroneous.

MPEP 806.05(a) states that "A combination is an organization of which a subcombination or element is a part." The examiner has failed to apply this definition to claims 1-21.

Group I recites a gas turbine engine component **COMBINATION** having a perforate wall, pores, and TBC.

Similarly, the Group II to VII claims recite species gas turbine engine component **COMBINATIONS** having perforate wall, pores, and TBC, and additionally bond coating, as also found in species claim 4.

A combination is a combination as recited. And, the examiner's mere contention that Group I includes subcombination claims is against the very evidence of these claims as expressly recited therein.

Note the conspicuously **common** elements of all twenty-one claims: metal wall, pores, and TBC. Where then is the examiner's support for distinguishing the claim groups as combination or subcombination, when the facts clearly support not only combination claims for all twenty-one claims, but those twenty-one claims all include the fundamental features of metal wall, pores, and TBC?

MPEP 806.05(c) requires the two tests (1) **AND** (2) which the examiner has failed to meet.

The examiner simply opines that: "In the instant case, the combination as claimed [of Groups II to VII] does not require the particulars of the subcombination as claimed [Group I] because the structure thereof can be formed without the details as recited in claims 4 to 15."

However, this contention is clearly erroneous, and the examiner's isolation of "claims 4 to 15" is not supported by the MPEP.

The MPEP mandates an analysis of **EACH** claim which the examiner proposes to restrict, and the examiner has failed to meet this burden.

Groups II to VII require the particulars of claim 1.

PATENT

Docket 13DV-14203

Groups II to VII require the particulars of claim 2.

Groups II to VII require the particulars of claim 4.

Groups II to VII require the particulars of claim 5.

It is irrelevant if Groups II to VII do not require the particulars of all species claims, or there could only be one claim in one application; and this is clearly untenable.

The examiner also opines that: "The subcombination [of Group I] has separate utility such as in any high temperature environment wherein heat transfer is to be minimized."

However, this bald conjecture disregards the Group I claims themselves, and does not meet the test that "the subcombination can be shown to have utility either by itself or in other and different relations."

Claim 1 does **NOT** claim "any high temperature environment" as the examiner contends. To the contrary, claim 1 expressly recites a gas turbine component; and Groups II to VII expressly claim species thereof.

Claim 1 expressly recites a perforate wall, pores, and TBC; and Groups II to VII expressly recite a perforate wall, pores, and TBC.

Should the examiner disregard the preamble of Group I to broaden the claim scope to cover "any high temperature environment wherein heat transfer is to be minimized," he must similarly disregard the preambles of Groups II to VII and broaden the scope of these claims to "any high temperature environment wherein heat transfer is to be minimized."

The examiner cannot both disregard the preamble in Group I and not disregard the preamble in Groups II to VII in the attempt to support restriction; since this is illogical and not supported by the MPEP.

The examiner has already indicated that Group I is limited to search class 428/621; and to now argue that the claims thereof have separate utility beyond that search class is illogical, and would require an exhaustive search by the examiner in the plethora of search fields inherent in the examiner's contention.

PATENT

Docket 13DV-14203

Since Group I has been provisionally elected, the examiner is now duty bound to produce a search report including references to "any high temperature environment wherein heat transfer is to be minimized." The next office action on the merits will reveal if the examiner stands consistent in his position, or not.

The examiner's contention that "Inventions II to VII are related as subcombinations disclosed as usable together in a single combination" is clearly erroneous on its face; and fails to meet the multiple tests required under the MPEP, including MPEP 806.05(d) identified by the examiner.

As indicated above, Groups II to VII are combination claims, not subcombinations; and the examiner has so admitted at the bottom of page 2 that: "Inventions I and II to VII (inclusive) are related as subcombination and combination, respectively...."

The examiner's failure to maintain consistent arguments in the restriction requirement necessarily fails to support that requirement. The examiner cannot argue inconsistent and opposite positions because the MPEP does not allow this, and because such inconsistent positions do not meet the due process requirement of fair prosecution before the USPTO.

MPEP 806.05(d) cautions the examiner that: "Care should always be exercised in this situation to determine if the several subcombinations are generically claimed."

The examiner has already admitted that at least claims 1 and 2 are generic, which renders the restriction requirement under MPEP 806.05(d) untenable. The Group II to VII claims are **species** claims having the common features of claim 1. The MPEP clearly mandates that a **reasonable** number of species are permitted in one application.

The natural consequence of the examiner's restriction requirement is the possibility of **seven** different patent applications, by division practice, all of which will necessarily include the species features of claims 1 and 2, for example, and all of which will necessarily require the

PATENT

Docket 13DV-14203

same search effort as in the present application, and the compounding of prosecution for no apparent benefit.

The examiner's proffered reason under MPEP 806.05(d) is illogical, and lacks the due care required therein. The examiner simply opines that: "In the instant case, the invention II has separate utility such as in a gas turbine wherein the nozzle vane, nozzle band etc do not have a perforate metal wall having a thermal barrier coating." What does this mean, how is this bald statement logical, and how does this meet MPEP 806.05(d)?

"Invention II" recites in the preamble a gas turbine engine combustion liner; and then recites specific elements in the body which are ~~common~~ to all Groups II to VII.

The examiner casually disregards the body features of these claims and baldly contends that his example "does not require a perforate metal wall having a thermal barrier coating;" yet this has no bearing on the claims, or under MPEP 806.05(d).

How can the examiner reasonably and logically contend that in his example the perforate wall and TBC are NOT found in the example when all the claims in Groups II to VII expressly recite the perforate wall and TBC? How can the examiner argue that the perforate wall and TBC of "invention II" may be omitted therefrom in meeting the requirements of MPEP 806.05(d) when this is not permitted by this section?

MPEP 806.05(d) expressly mandates that: "The examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination."

The subcombination of perforate wall, pores, and TBC is found in all Groups and is found in all the recited combinations, and it is therefore impossible for the examiner to support any restriction under MPEP 806.05(d), which has different requirements than mere species selection pending allowance of a generic claim.

As indicated above, Applicants have provisionally elected the examiner's contention of "Species B" as introduced in

PATENT

Docket 13DV-14203

claim 4. It is also noted for the examiner's species election that this "bond coating" species is also recited in claims 5-15, 16, 17, 18, 19, 20, and 21; which would require rejoinder for yet another reason.

Claims 4-15 and 16-21 appear to read on the "Species B wherein the component has a bond coating."

Applicants note the rights under Rule 141.

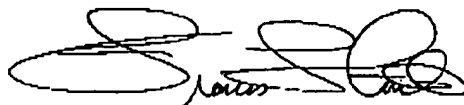
In summary, the examiner has failed to meet the several requirements under the MPEP for supporting the restriction requirement of any of the seven groups; and withdrawal of the entire restriction requirement is therefore warranted and is requested.

Applicants provisionally elect the Group I invention, including claims 1 to 15 as listed by the examiner.

Applicants provisionally elect the "Species B wherein the component has a bond coating," with claims 5-21 being readable on this "Species B wherein the component has a bond coating."

However, withdrawal of the restriction requirement is warranted, and examination of all claims 1-21 is requested, with due searching in the various search classes for the recited gas turbine engine components in their various forms.

Respectfully submitted,



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Date: 5 Feb 2003

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